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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,109	01/18/2002	Massimo Debenedetti	Q68049	6560

7590

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EXAMINER

GREENE, JASON M

ART UNIT

PAPER NUMBER

1724

DATE MAILED: 07/15/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

10/050,109

Applicant(s)

DEBENEDETTI ET AL.

Examiner

Jason M. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claims*

2. The attempt to incorporate subject matter into this application by reference to international patent application WO 00/69542 in claim 9 is improper because essential subject matter by reference to a foreign application or patent, or to a publication is improper. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). Since the subject matter sought to be incorporated is recited in the instant claims, the subject matter is seen as being essential subject matter.

Additionally, the Examiner notes that while the specification makes mention of international patent application WO 00/69542 in page 1, line 10 to page 2, line 15, the international patent application is not explicitly incorporated by reference into the disclosure. However, since the claims of the international application are incorporated by reference into the language of claim 9, the material recited in the process claims of

the international application is seen as forming a part of the instant claim language.

Therefore, the material recited in the process claims of the international application may be introduced into the instant disclosure without constituting new matter.

3. Applicant is reminded that while reference to elements of figures is allowed in the claims, the claims must be able to stand independent of the figures.

With regard to claim 1, the Examiner suggests Applicants change the word “plane” in line 9 to the word “planar” to correct a minor grammatical informality.

4. With regard to claim 6, the Examiner suggests Applicants rewrite the phrase “bell-like” in lines 2-3 as the phrase “bell-shaped” to improve the clarity and precision of the claim language.

5. With regard to claim 8, the limitation “the adjacent and the facing elements of the two arrays” has been interpreted as being an element of the first array and an adjacent element of the second array which faces the element of the first array.

6. With regard to claim 9, the reference to the claims of the international application should be deleted since the claims in the international application are subject to change. The Examiner suggests Applicants cancel claim 9 and reintroduce the subject matter as new dependent claims including the limitations recited in the process claims of the international application.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 9 recites the filtering elements being obtained with a process according to one or more of the claims of international patent application WO 00/69542. Independent process claim 1 of international patent application WO 00/69542 discloses the filtering elements being obtained using a powder having a purity over 97 percent, a mean particle size of less than 2  $\mu\text{m}$ , and a specific surface of at least greater than 5  $\text{m}^3/\text{g}$ . However, the instant specification does not disclose the filtering elements being formed from powders having the recited properties. The Examiner further notes that dependent claims 2-11 of international patent application WO 00/69542 also recite additional limitations that are not disclosed in the instant specification.

***Allowable Subject Matter***

9. Claims 1-8 are allowed.
10. Claim 9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
11. The following is a statement of reasons for the indication of allowable subject matter:

Gabathuler et al. discloses a particulate filter for diesel engines comprising a metal shell or casing (20) defining a cavity with an intake pipe and an outlet pipe, and a filtering body (11) made of ceramic foam set in the path of communication between said intake pipe and said outlet pipe, wherein said filtering body is made up of a plurality of separate elements (11) made of ceramic foam, which are set about a longitudinal axis of the shell in such a way as to define, inside the shell, an inner chamber set inside the array of filtering elements and at least one outer chamber set outside the array, the said chambers respectively communicating with said intake pipe and with said outlet pipe, or vice versa, in such a way that, during use, the flow of the engine exhaust gases that traverses said shell passing from the intake pipe to the outlet pipe (or vice versa) is forced to traverse the aforesaid filtering elements, thus

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assuming a component of radial velocity with respect to the longitudinal axis of the shell in Figs. 1 and 2 and col. 2, line 29 to col. 3, line 60.

The prior art made of record does not teach or fairly suggest the particulate filter of claim 1 wherein the ceramic foam filtering elements have a substantially planar and elongated shape.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Ciliberti, Kemmelmeyer, Abthoff et al., Adiletta, Matsunuma et al., and Wörner et al. references disclose similar particulate filters.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (703) 308-6240. The examiner can normally be reached on Tuesday - Friday (7:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (703) 308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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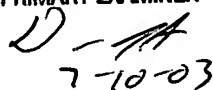
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jason M. Greene  
Examiner  
Art Unit 1724



jmg  
July 10, 2003

DUANE SMITH  
PRIMARY EXAMINER

  
7-10-03